

REMARKS

Claims 1-25 are pending in this application. Claims 1, 12, 18, 22, and 25 are independent. In light of the remarks contained herein, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections.

In the outstanding Official Action, the Examiner objected to the Abstract of the Disclosure. The Examiner further rejected claims 1-3, 8, 10, 12-13, and 21-23 under 35 U.S.C. § 102(b) as being anticipated by *Sklarew* (USP 4,972,496); rejected claims 4 and 5 under 35 U.S.C. § 103(a) as being unpatentable over *Sklarew* in view of *Gough et al.* (USP 5,603,053); rejected claim 6 under 35 U.S.C. § 103(a) as being unpatentable over *Sklarew* and *Gough et al.* in view of Microsoft PowerPoint; rejected claim 7 under 35 U.S.C. § 103(a) as being unpatentable over *Sklarew* in view of *Borgstrom et al.* (USP 6,738,053); rejected claim 9 under 35 U.S.C. § 103(a) as being unpatentable over *Sklarew* in view of *Wildermuth* (USP 5,950,188); rejected claims 11, 14-15, 17, and 24 under 35 U.S.C. § 103(a) as being unpatentable over *Sklarew* in view of *Lamming* (USP 5,535,063); rejected claim 16 under 35 U.S.C. § 103(a) as being unpatentable over *Sklarew* and *Lamming*, and further in view of *Morishita et al.* (USP 6,335,727); and rejected claims 18-20 and 25 under 35 U.S.C. § 103(a) as being unpatentable over *Sklarew* in view of *Eichstaedt et al.* (USP 6,563,494). Applicants respectfully traverse these rejections.

Specification

The Examiner objected to the Abstract of the Disclosure. By this Amendment, Applicants have amended the Abstract to comply with the suggestions as set forth by the Examiner. Based upon this amendment, it is respectfully requested that the outstanding objection be withdrawn.

Claim Rejections - 35 U.S.C. § 102

In Applicants' Reply filed September 14, 2004, Applicants presented arguments that *Sklarew* fails to teach or suggest wherein at least one input field is provided with a position-coding pattern and is adapted to be filled in by a drawing device which records, using the position-coding pattern, positions in the input field in order to digitally record information entered in the input field. The Examiner's attention is respectfully directed to pages 12-14 of Applicants' Reply of September 14, 2004.

In response to Applicants' arguments, the Examiner merely responds by asserting that *Sklarew* clearly teaches the device to record positions using the positional coordinates from the screen, citing to col. 5, lines 57-67. Applicants respectfully submit that this assertion fails to adequately address Applicants' arguments. Applicants further respectfully submit that these teachings are insufficient in order to anticipate the present invention as set forth in claim 1.

The present invention as set forth in claim 1 recites, *inter alia*, a filing apparatus comprising means for holding a plurality of sheets wherein at least one input field is provided with a position-coding pattern which is adapted to be filled in by a drawing device which records, using the position-coding pattern, positions in the input field in order to digitally record information entered in the input field.

In contrast, the disclosure of *Sklarew* discloses a stylus 16 connected to the computer of system 10 with a wire 17. As the stylus 16 writes on the input screen 18, a plurality of locating signals representative of a plurality of corresponding positional coordinates are transmitted to microcomputer 14. Applicants maintain that these teachings are insufficient to teach or suggest the position-coding pattern of the present invention. Applicants further submit that these teachings are insufficient to teach or suggest a drawing device which records, using the position-coding pattern, positions of the input field in order to digitally record information entered in the input field. Applicants respectfully request that the Examiner provide a detailed explanation as to how *Sklarew* teaches a drawing device of the present invention which records, using the position-coding pattern, positions of the input field in order to digitally record information entered in the input field.

Applicants maintain that, as *Sklarew* fails to teach or suggest these claim elements, *Sklarew* fails to anticipate the present invention. As such, it is respectfully requested that the outstanding rejection be withdrawn.

It is respectfully submitted that claims 2-11 and 21 are allowable for the reasons set forth above with regard to claim 1 at least based upon their dependency on claim 1. It is further respectfully submitted that claims 12 and 22 contain elements similar to those discussed above with regard to claim 1, and thus claims 12 and 22, together with claims dependent thereon, are not anticipated by *Sklarew* for the reasons set forth above with regard to claim 1.

In support of the Examiner's rejection of claim 22, the Examiner states that the claim is similar in scope to independent claim 1 and therefore rejected under the same rationale. However, Applicants respectfully submit that claim 22 includes elements that require separate consideration from claim 1 and submit that claim 22 is not anticipated by *Sklarew*.

The present invention as set forth in claim 22 recites, *inter alia*, a filing device comprising a holder for holding a plurality of tangible sheets. Applicants cannot discern from the outstanding Official Action what portion of the *Sklarew* reference the Examiner is relying upon to teach this claim element. Clearly, the handwritten keyboardless entry computer system of *Sklarew* does not

incorporate tangible sheets. Applicants respectfully submit that, as *Sklarew* fails to teach or suggest all of the claim elements, claim 22 is not anticipated by *Sklarew*. As such, it is respectfully requested that the outstanding rejection be withdrawn.

**Claim Rejections - 35 U.S.C. § 103 -
*Sklarew/Borgstrom et al.***

In Applicants' Reply filed September 14, 2004, Applicants argued that the Examiner had failed to establish *prima facie* obviousness under 35 U.S.C. § 103 by failing to provide references that teach or suggest all of the claim elements. Specifically, Applicants argued that there was no disclosure either in *Sklarew* or *Borgstrom et al.* that was directed to receiving buffered position information from a drawing device as set forth in claim 18. Although the Examiner indicates that Applicants' Reply has been fully considered, the Examiner has failed to address this argument.

Applicants maintain that the Examiner's rejection fails to establish *prima facie* obviousness by failing to teach or suggest all of the claim elements. Applicants respectfully request that the outstanding rejection be withdrawn. In the event that the Examiner maintains this rejection, Applicants respectfully request the Examiner withdraw the finality of the outstanding Official Action and properly respond to Applicants' arguments in a new Official Action.

It is respectfully submitted that claims 19-20 are allowable for the reasons set forth above with regard to claim 18 at least based upon their dependency on claim 18.

Claim 25 recites, *inter alia*, a drawing device comprising a memory for storing the sensed positional information. As noted above with regard to claim 18, the cited references fail to teach or suggest a drawing device buffering information. As neither of the references, either alone or in combination, teach or suggest all of the claim elements, it is further respectfully submitted that claim 25 is patentable over the references as cited.

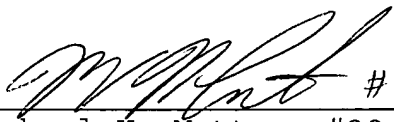
Conclusion


Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Catherine M. Voisinnet (Reg. No. 52,327) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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MKM/CMV/jdm
3782-0193P

Attachment: New Abstract of the Disclosure